

REMARKS

The Office Action

Claims 1 – 10, 28 – 29, and 31 – 37 were rejected for anticipation by Niven et al. (U.S. Patent No. 4,727,889; hereafter “Niven”). Claim 30 was rejected for obviousness over Niven in view of Ohno et al. (U.S. Patent No. 4,211,243; hereafter “Ohno”). Claims 11 – 27 were rejected for obviousness over Niven in view of Baehl et al. (U.S. Pat. No. 6,209,546; hereafter “Baehl”). Each of these rejections is addressed in turn below.

Support for the Amendments

Claims 1, 2, 3, 4, and 5 have been amended for clarity. No new matter has been added.

Rejections under 35 U.S.C. § 102

Claims 1 – 10, 28 – 29, and 31 – 37 stand rejected under § 102 as being anticipated by Niven. M.P.E.P. § 2131 states:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

In view of this standard, Applicants traverse this rejection.

Claims 1 – 5, from which all other claims depend, recite methods for the reduction of a constituent present in tobacco using a *subcritical* fluid. In each of these methods, tobacco is contacted with subcritical fluid, a tobacco constituent dissolves in the fluid,

and the subcritical fluid is removed from the tobacco thereby reducing the amount of the constituent in the tobacco. In contrast, Niven describes a method for the reduction of components from tobacco using *supercritical* fluid. With reference to Niven the Office states that “tobacco in container 20 is subjected to subcritical carbon dioxide fluid during expansion, and then said fluid is removed from the container.” While Niven does disclose the use of subcritical fluid, it is as a fluid already containing the extracted components that is used to deposit the extracted components onto a smokable material. Thus, independent claims 1 - 5 and Niven employ subcritical fluid in a dissimilar manner. The methods of claims 1 - 5 employ subcritical fluid to *decrease* the amount of a constituent in tobacco, while Niven uses subcritical fluid to *increase* the amount of components in tobacco. Since Niven does not teach every element of claims 1 - 5, Niven is not anticipatory. The rejection may be withdrawn.

Rejections under 35 U.S.C. § 103

Claim 30 stands rejected under § 103 for obviousness over Niven in view of Ohno, and claims 11 – 27 stand rejected for obviousness over Niven in view of Baehl. In order to reject the aforementioned claims for obviousness, the Office must put forth a *prima facie* case that meets the legal standard for obviousness found in M.P.E.P. § 2142. This section states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference

teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all the claim limitations.

In view of this standard, Applicants traverse these rejections.

Regarding claim 30, the rejection is based on the Office's incorrect belief that Niven teaches each of the limitations of claims 1 - 5. As stated above, Niven does not teach the limitations of claims 1 – 5, as these claims are directed to methods in which tobacco is extracted with a *subcritical* fluid in order to remove a tobacco constituent. In contrast, Niven employs *subcritical* fluid for deposition of tobacco components on tobacco. The teachings of Ohno on pH do not remedy the deficiencies of Niven with respect to the independent claims. Thus, the references alone or in combination fail to teach or suggest all the claim limitations. As such, the Office has failed to establish a *prima facie* case of obviousness, and the rejection may be withdrawn.

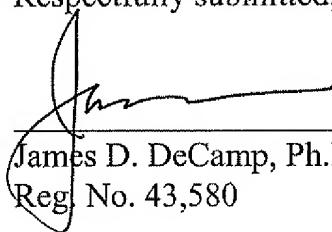
Regarding claims 11 – 27, the rejection is also based on the Office's incorrect belief that Niven teaches each of the limitations of claims 1 - 5. The deficiencies of Niven are discussed above. Baehl recites a method for recovering tobacco expansion agents in order to recycle and reuse the expansion agents in subsequent processes. These teachings of Baehl do not remedy the deficiencies of Niven with respect to the independent claims. Again, the references alone or in combination fail to teach or suggest all the claim limitations. The rejection may also be withdrawn.

CONCLUSION

Applicants submit that the claims are in condition for allowance, and such action is respectfully requested.

If there are any charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,


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